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JGJr: 09-04

Paper No: ____

BRISTOL-MYERS
SQUIBB COMPANY
100 HEADQUARTERS PARK DRIVE
SKILLMAN NJ 08558

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SEP 13 2004

OFFICE OF PETITIONS

In re Application of	:	
Falconer.	:	
Application No. 10/780,240	:	ON PETITION
Filed: 17 February, 2004	:	
Attorney Docket No. C-314 DIV	:	

This is a decision on the petition filed on 6 August, 2004, and considered under 37 C.F.R. §1.53, to obtain a filing date of 17 February, 2004, for the application, rather than no filing date as presently accorded.

For the reasons set forth below, the petition is **GRANTED in part** and **DISMISSED in part**.

BACKGROUND

This application was deposited on 17 February, 2004.

On 15 June, 2004, the Office mailed a Notice of Incomplete Nonprovisional Application (the 15 June Notice) indicated that no filing date had been accorded because the application had been filed without drawings as required under 35 U.S.C. §113 (first sentence). That Notice reminded Petitioner that any filing date accorded would be "the date of receipt of" the drawing(s) if submitted.

NOTE: A review of the Application as deposited indicate that Petitioner's Claim 37 appears to contain a methods/process claim.

On 6 August, 2004, Petitioner filed a Response to the 15 June Notice, and included therewith a copy of drawings (sheets 1 - 9, Figs, 1 - 12e).

Petitioner indicates that this application is a divisional of Application No. 09/370,305 (filed 9 August, 1999), which has since issued as Patent No. 6,709,421B1 on 23 March, 2004, and that this application contained no new matter from the parent.

Analysis

A search of the official file reveals that on 17 February, 2004, Petitioner deposited the instant application, and stated therein:

- at item 4 on the Transmittal Sheet: "[t]he entire disclosure of the prior application . . . is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein . . ."; and
- at the bottom of that Transmittal Sheet: "[t]he right to elect an invention or species that is different from that elected in parent Application No. 09/370,305 in the event of a restriction or election of species requirement that is identical or substantially similar to that made in said parent application is hereby reserved."

While Petitioner does not allege that the drawings found to be missing from the application are not necessary for the understanding of the invention, it is the practice of the Office to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for the understanding of the invention under 35 U.S.C. § 113 (first sentence). (See: MPEP §601.01¹)

¹ The commentary at MPEP §601.01 provides in pertinent part:

* * *

601.01(f) Applications Filed Without Drawings

35 U.S.C. 111(a)(2)(B) and 35 U.S.C. 111(b)(1)(B) each provide, in part, that an "application shall include . . . a drawing as prescribed by section 113 of this title" and 35 U.S.C. 111(a)(4) and 35 U.S.C. 111(b)(4) each provide, in part, that the "filing date . . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office." 35 U.S.C. 113 (first sentence) in turn provides that an "applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.

Applications filed without drawings are initially inspected to determine whether a drawing is referred to in the specification, and if not, whether a drawing is necessary for the understanding of the invention. 35 U.S.C. 113 (first sentence).

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition applications.

* * *

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject

This application contains at least one method claim, as noted above. Therefore, the application should have been treated as an application filed without the drawing figure(s) referred to in the specification as discussed in MPEP §601.01(g).²

It appears that a "Notice of Omitted Items" should have been mailed instead of the "Notice of Incomplete Nonprovisional Application."

Therefore, the 15 June, 2004, "Notice of Incomplete Nonprovisional Application" hereby is vacated.

CONCLUSION

The petition is:

- **granted in part**, to the extent that the application will be accorded the filing date of 17 February, 2003, without the sheets 1 - 9 of drawings containing Figs. 1 - 12e as part of the original disclosure of the application; and
- **dismissed in part** as to the request for the 17 February, 2004, filing date for sheets 1 - 9 of drawings containing Figs. 1 - 12e.

matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed for examination, so long as the application contains something that can be construed as a written description. A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate Technology Center (TC) determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the USPTO.

* * *

² The commentary at MPEP §601.01 provides in pertinent part:

* * *

601.01(g) Applications Filed Without All Figures of Drawings

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification. The mailing of a "Notice of Omitted Item(s)" will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the drawing(s) was in fact deposited in the USPTO with the application papers must, within 2 months from the date of the "Notice of Omitted Item(s)," file a petition under 37 C.F.R. 1.53(e) with the petition fee set forth in 37 C.F.R. 1.17(h), along with evidence of such deposit (37 C.F.R. 1.181(f)). The petition fee will be refunded if it is determined that the drawing(s) was in fact received by the USPTO with the application papers deposited on filing.

* * *

Because the omission of Fig. 1 and the petition as to its inclusion was not due to Office error, the petition fee is charged, as authorized, to Deposit Account 02-3869.

Petitioner asserts that the first paragraph of the specification states that the application is a continuation of Application No. Application No. 09/370,305, and pending as of the filing of the instant application), and that "... incorporated by reference ..."

This incorporation may be proper in practice before the Office. (See: MPEP §201.06(c) (in pertinent part).)³ As a matter of expediting prosecution, Petitioner may submit a copy of the parent application (Application Serial No. 09/370,305) with a preliminary amendment and seek entry of that amendment by the Examiner.

The application file is being released to the Office of Initial Patent Examination for further processing with a corrected filing date of 17 February, 2003, indicating in the Office records that "0" sheets of drawings were present on filing, and the mailing of a corrected filing receipt.

Telephone inquiries concerning this decision may be directed to the undersigned at (703)305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The commentary at MPEP §201.06(c) provides in pertinent part:

INCORPORATION BY REFERENCE

In a continuation or divisional application, the safe-guard (petition and fee under former 37 C.F.R. 1.60(b)) concerning the filing of an application lacking all of the pages of the specification or sheets of drawings of the prior application has not been retained in 37 C.F.R. 1.53(b) since the specification and drawings of a continuation or divisional application are not limited to a reproduction or a "true copy" of the prior application. As a safeguard, however, an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. (Emphasis supplied.).